



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,391	07/01/2003	Susan Hickey	100041-41143	1534

7590 02/23/2005

Mark P. Levy, Esq.
Thompson Hine LLP
2000 Courthouse Plaza NE
10 W. Second Street
Dayton, OH 45402-1758

EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
----------	--------------

3611

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,391

Applicant(s)

HICKEY ET AL.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the non-skid surface (non-skid portion) defined in claims 34 and 36 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Art Unit: 3611

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Stating in claim 8 that each sheet is joined to at least one adjacent sheet by a binding means.

Claim Rejections - 35 USC § 112

Claims 34-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 34 and 36, stating that the backing portion has a non-skid surface is considered to be new matter. The specification, page 2, lines 22-23 state that the backing portion may include a “nonskid portion” located on a lower surface thereof. In regard to claims 35 and 37, stating that the anti-static coating covers “substantially the entire upper surface of each sheet” is considered to be new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8,10-14,28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261).

Art Unit: 3611

G.B. '520 shows in figures 1-5 a mouse pad that includes a plurality of stacked sheets (block of sheets labeled 1) wherein each adjacent sheet is joined to another adjacent sheet along at least two separate edges. G.B. '520 discloses on page 1, three lines from the bottom, the idea of placing a calendar on each of the stacked sheets. G.B. '520 does not disclose whether the calendar portion has a time period of at least one week. Glass shows in figure 1 the idea of placing a calendar portion (month of January) that includes a time period of at least one week. In view of the teachings of Glass it would have been obvious to one in the art to modify G.B. '520 by placing a calendar portion having a time period of at least one week onto each of the sheets since this would allow an entire month to be displayed by a single sheet which would make the sheets more useful. In regard to claim 2, the sheets of G.B. '520 are made out of paper and are considered to have a charge of less than 10 volts when the mouse pad is grounded (a persons hand resting on the pad, the pad resting on a metal surface, etc.) and when it hasn't been used for an extended period of time the mouse pad would have little or no charge. In regard to claims 3,4, and 6, the sheets are generally rectangular with rounded corners and are adhered together with adhesive along three edges, see figures 4 and 5. In regard to claims 5 and 11, Glass discloses the idea of placing different calendar portions on each sheet, see page 1, column 2, lines 36-47. In regard to claim 7, the adhesive used is inherently weaker than the sheets since the sheets are separated from one another without damaging the sheets, see figure 5. In regard to claim 8, as broadly defined, the adhesive is considered to be the binding means. In regard to claim 10, the sheets of G.B. '520 are generally aligned. In regard to claims 12 and 13, Glass discloses that each sheet includes a month of the year in order, see page 1, column 2, lines 36-47. In regard to claim 14, G.B. '520 shows a backing pad (2). In regard to claim 28, the steps

Art Unit: 3611

defined are the conventional steps that are followed in using a mouse pad, i.e. locating a computer mouse onto the mouse pad, moving said mouse along the pad to cause movement of a cursor on a computer display. In regard to claim 29, G.B. teaches the idea of removing a top sheet to expose another sheet, see page 2, fourth new paragraph which starts with "Referring".

Claims 2,9,15-27 and 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Great Britain 2,289,520 in view of Glass (U.S. Patent No. 1,906,261) as applied to claim 1 above and further in view of Scianna (U.S. Patent No. 5,997,995) and Savit (U.S. Patent No. 4,454,058) or the applicant's admitted prior art in the remarks section of the amendment filed on Nov. 19, 2004, page 11, lines 4-12.

In regard to claims 2,15, and 30, G.B. '520 in view of Glass disclose the applicant's basic inventive concept except for providing each sheet with an anti-static property or a reduced static electricity charge. Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. Therefore, Scianna recognizes the desirability of reducing static on mouse pads. Savit discloses the idea of coating paper to reduce the static on the paper by increasing the surface-conductivity of a substrate. The applicant discloses in the remarks section that the anti-static coatings used in the applicant's invention are known in the art. In view of the teachings of Scianna and Savit or the applicant's admitted prior art in the remarks section it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets since this would reduce the amount of static electricity stored on the sheets which would help to prevent damage to electrical components and accumulation of dust and dirt. In regard to claims 9 and 27, G.B. '520 in view of Glass disclose

Art Unit: 3611

the applicant's basic inventive concept except for making the resistivity of each sheet between 800 and about 3000 ohms. G.B. '520 fails to disclose the resistivity of the sheets but does disclose that the sheets are made from paper. Paper inherently has a high resistivity since it is an insulator. Paper would have a resistivity higher than the range specified by the applicant.

Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. Therefore, Scianna recognizes the desirability of reducing static on mouse pads. Savit discloses the idea of coating paper to reduce the static on the paper by increasing the surface-conductivity of a substrate. Increasing the surface conductivity would reduce the resistivity of the paper sheets of G.B. '520. The applicant discloses in the remarks section that the anti-static coatings used in the applicant's invention are known in the art. In view of the teachings of Scianna and Savit or the applicant's admitted prior art in the remarks section it would have been obvious to one in the art to modify G.B. '520 by adding an anti-static coating to the sheets (which would reduce the resistivity) since this would reduce the amount of static electricity stored on the sheets and would provide a resistivity of between about 800 and about 3000 ohms. It is considered within one skilled in the art to vary the conductivity of the coating, and hence the resistivity, to reach the desired level. In regard to claims 16,35, and 37, Savit and the applicant's admitted prior art disclose the idea of making the anti-static material in the form of a coating. In regard to claims 17 and 31, the sheets would carry a voltage of less than 10 volts when it is grounded and when it hasn't been used for a long period of time.

Further, with the anti-static coatings taught by Savit and the applicant's admitted art the sheets would hold less than 10 volts of static charge. The structure defined in claims 18-26,32, and 33 similar to the structure in claims 3-14 and therefore have already been addressed. In regard to

Art Unit: 3611

claims 34 and 36, G.B. '520 shows a non-skid surface (3) in figure 3. In regard to claims 35 and 37, it would have been obvious to one having ordinary skill in the art to cover the entire top surface of the sheets with the anti-static coating since this would further minimize the amount of static charge stored on each of the sheets.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Feb. 18, 2005